

REMARKS

I. Status of the Claims

Claims 80, 82, 84-149 and 167-186 stand rejected. Claims 81, 83 and 150-166 are withdrawn from consideration. Without prejudice or disclaimer claims 84, 85, 94-96, and 101-103 w canceled. Claims 80-83, 86-90, 92, 97-100, 104-111, and 114-117, 139, 141, and 181 have been amended. By this Amendment, claims 80-83, 86-93, 97-100, and 104-186 are pending.

Claims 80, 81, 82, and 83 have been amended to incorporate the elements of claim 102, which has been canceled, and now recite, *inter alia*, "...at least one volatile hydrocarbon-based oil; at least one first volatile silicone oil with a flash point of greater than or equal to 55 °C and less than or equal to 80 °C; at least one second volatile silicone oil with a flash point of greater than or equal to 80 °C and less than or equal to 95 °C...." Claims 86-90, 92, 97, 98, 104-111, and 114-117 have been amended to maintain strict antecedent basis and to further improve clarity. Claims 139, 141, and 181 have been amended to correct minor typographical errors.

Support for these amendments can be found in the as-filed specification and claims. Accordingly, Applicants submit that this amendment has full support under 35 U.S.C. § 112, first paragraph.

II. Rejection under 35 U.S.C. § 112

The Examiner has rejected claims 80, 82, 84-149, and 167-186 under 35 U.S.C. § 112, second paragraph, as being "indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention." *Office Action* at p. 2. The Examiner states that the use of the phrase "greater than or equal

to,” particularly in the claims “when describing the weight ratio of (water+polyol) to oil; the silicone oil (claim 102); the total content of solid particles,” are unclear as to their intended values. See *id.* Applicants respectfully disagree.

Claims 84, 85, 94-96, and 101-103 have been canceled and therefore this rejection is moot with respect to those claims. With respect to claim 175, Applicants submit that claim 175 does not recite the term “greater than or equal to;” rather, claim 175 recites “less than or equal to.”

Turning to the substance of the rejections, and regardless of whether the claims recite “greater than or equal to” or “less than or equal to,” one of ordinary skill would clearly interpret the scope of the claimed language of “greater than or equal to” to mean that the claimed value can be either equal to or greater than the claimed value. Similarly, the skilled artisan would also interpret those claims reciting “less than or equal to” to mean that the claimed value can be either equal to or less than the claimed value.

Thus, one of ordinary skill would clearly understand this meaning on its face. Moreover, the Office has shown no legal basis, nor does any exist, for requiring Applicants to change it. Therefore, Applicants respectfully submit that this rejection is improper, and should be withdrawn.

III. Rejections under 35 U.S.C. § 103(a)

Claims 80, 84-117, 124-130, 140-149, 175-176, and 178-186 are rejected under 35 U.S.C § 103(a) as allegedly being unpatentable over U.S. Patent No. 5,843,417 to Hanna et al. (“Hanna”) in view of U.S. Patent No. 4,552,753 to Elm et al. (“Elm”). *Office Action* at pp. 4-7. The Examiner alleges that Hanna discloses a water-in-oil emulsion comprising a water phase and an oil phase, and further containing a particle, surfactant,

polymer, and other ingredients that are common to cosmetic compositions. *Id.* at p. 5.

However, the Examiner states that “Hanna et al. do not teach the claimed concentration of the ingredients, the viscosity of the composition and the specific volatile silicone oils as claimed by applicant.” *Id.* In view of these deficiencies, the Examiner relies upon the teachings of Elm for its disclosure of specific cyclic and linear volatile silicone oils that are “common for use in cosmetics.” *Id.* at pp. 5-6.

Therefore, the Examiner alleges that “[i]t is within the ability of one of ordinary skill in the art to adjust the viscosity and concentration of the ingredients” to arrive at the desired formulation, and “it would have been obvious to one of ordinary skill in the art to look to the teachings of Elm et al. for examples of linear and cyclic volatile silicone oils that are commonly used in cosmetics [and] . . . one would expect a reasonable chance of success as Hanna et al. broadly describe [silicone oils]. . . .” *Id.* at p. 6. Applicants respectfully disagree with the Examiner’s conclusion for at least the reasons of record and in view of at least the following additional reasons.

The standards for an obviousness analysis have been delineated in *Graham v. John Deere*, 383 U.S. 1, 148 U.S.P.Q. 459 (1996). The four factual inquiries enunciated therein as a background for determining obviousness are as follows:

- (A) Determining the scope and content of the prior art;
- (B) Ascertaining the differences between the prior art and the claims in issue;
- (C) Resolving the level of ordinary skill in the pertinent art; and
- (D) Evaluating evidence of secondary considerations.

See M.P.E.P. § 2141(II).

Upon resolving these four inquiries, the key to supporting any rejection under 35 U.S.C. § 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. Indeed, the Supreme Court mandates that “[t]o facilitate review, this analysis [of whether there was an apparent reason to combine the known elements in the fashion claimed by the patent at issue] should be made explicit.” *KSR Int’l Co. v. Teleflex Inc., et al.*, 127 S. Ct. 1727, 1741, 82 U.S.P.Q.2d 1385, 1396 (2007) (citing *In re Kahn*, 441 F.3d 977, 988, 78 U.S.P.Q.2d 1329, 1336 (Fed. Cir. 2006) (“[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.”)); see also M.P.E.P. § 2141(III).

Here, the cited references fail to meet these standards. Independent claim 80 has been amended to include the recitations in claim 102, which has been canceled. Amended claim 80 now recites:

A fluid foundation composition in the form of a water-in-oil emulsion, comprising:

at least one volatile hydrocarbon-based oil;

at least one first volatile silicone oil with a flash point of greater than or equal to 55°C and less than or equal to 80 °C;

at least one second volatile silicone oil with a flash point of greater than or equal to 80 °C and less than or equal to 95 °C;

an aqueous phase containing water and at least 6% by weight of water-miscible polyol, relative to the total weight of the composition, and

at least 8% by weight of dyestuff,

wherein the water, the polyol, and the oil are present in an amount such that the weight ratio of (water + polyol) to oil is greater than or equal to 0.8. (emphasis added).

Although the Examiner rejects claim 102 based on Hanna in view of Elm, Hanna does not teach or suggest all of the present claim limitations. Hanna's composition does not contain a disclosure of a fluid foundation composition comprising the combination of at least one volatile hydrocarbon-based oil; at least one first volatile silicone oil with a flash point of greater than or equal to 55 °C and less than or equal to 80 °C; and at least one second volatile silicone oil with a flash point of greater than or equal to 80 °C and less than or equal to 95 °C.

The Examiner relies on col. 2, line 62 - col. 3, line 44 of Hanna for a teaching of "10 -55% oil in the W/O emulsion." *Office Action* at p. 5. Applicants continue to disagree with the Examiner's reliance on this passage. Hanna simultaneously teaches away from these elements, even in portions of the disclosure immediately adjacent to that relied upon by the Examiner. First, Hanna explicitly states that an object of the disclosed invention is to provide a W/O emulsion product "which contains no silicone oil such as volatile silicones." *Hanna* at col. 1, lines 37-38. Second, although Hanna states, at col. 3, lines 33-36, that the "present invention oil may contain, in addition to the hydrocarbon oils, other oils... such as silicone oils, including volatile silicone oils," Hanna states just a few lines later that the "absence of silicone oils such as volatile silicone oils in the invention oil is another preferred embodiment." *Id.* at col. 3, lines 43-44.

One of ordinary skill in the art reading Hanna would have been unlikely to use any volatile silicone oils or indeed any volatile oils. Prior art must be considered in its entirety, including disclosures that teach away from the claims. M.P.E.P. §§ 2141.02 and 2143.01. The inconsistent and predominantly negative (i.e., regarding use of

volatile oils) disclosure of Hanna cannot justifiably be considered support for a prima facie case of obviousness.

Moreover, Hanna does not disclose or suggest introducing the combination of at least one volatile hydrocarbon-based oil with at least two different volatile silicone oils having distinct flash points. Hanna mentions that “[t]he present invention oil may contain . . . other oils commonly used in W/O cosmetic emulsions such as silicone oils....” *Id.* at col. 3, lines 33-36. However, there is no guidance in Hanna to specifically choose at least two volatile silicone oils, let alone the combination of at least one volatile silicone oil with a flash point of greater than or equal to 55 °C and less than or equal to 80 °C, and at least one second volatile silicone oil with a flash point of greater than or equal to 80 °C and less than or equal to 95 °C. There is simply no guidance in Hanna to use these at least two volatile silicone oils containing the claimed flashpoints.

Accordingly, Elm must cure these deficiencies by providing the skilled artisan with a finding that would allow one of ordinary skill to recognize that combining the elements of Elm with Hanna would yield predictable results. For the following reasons, Elm is lacking in this regard.

Elm teaches an antiperspirant composition comprising a mixture of one or more volatile silicone oils and an antiperspirant active. *Elm* at col. 2, lines 16-24. Notably, Elm is directed to antiperspirant compositions and not water-in-oil emulsions, which are further absent volatile hydrocarbon-based oils. Elm provides no disclosure or suggestion of a composition comprising other acceptable oils that may be useful, much less a water-in-oil emulsion comprising at least one volatile hydrocarbon-based oil as claimed. Accordingly, there would be no apparent reason as to why one of ordinary

skill would be motivated to combine elements from the non-water-in-oil emulsion of Elm, absent any volatile hydrocarbon-based oil, with the W/O emulsion of Hanna, which are notably absent of additional volatile silicone oils having distinct flashpoints, and recognize that such a combination would afford predictable results. Without the benefit of hindsight, the skilled artisan would not arrive at the claimed invention.

For at least the aforementioned reasons, there is no finding that would motivate one of ordinary skill in the art to combine the elements of Hanna and Elm as claimed, and further recognize that the combination of these elements would have been predictable. Thus, Applicants respectfully submit that the Examiner has failed to establish a prima facie case of obviousness, and request that this rejection be withdrawn.

IV. Double Patenting Rejection

Claims 80, 82, 84-149 and 167-186 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-12, 15 and 18-99 of copending U.S. Application No. 10/603,698 ("the '698 application") for the reasons set forth at pages 3-4 of the Office Action. Since the '698 application was filed prior to the present application, Applicants respectfully request that the Examiner hold this rejection in abeyance until there is an indication of allowable subject matter in either this application or the '698 application. At that time, it would be possible to determine in which of these two applications, if any, a Terminal Disclaimer would need to be filed. See M.P.E.P. §I.B.1.

V. Conclusion

In view of the foregoing amendments and remarks, Applicants respectfully request reconsideration of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to Deposit Account No. 06-0916.

Respectfully submitted,

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